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09/909,501	07/20/2001	Steven C. Johnson	10003562-1	4153

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EXAMINER

NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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DETAILED ACTION

Claims 1-25 are currently presented and have been examined.

It is noted that a new Examiner has been assigned to this application. Any future correspondence regarding this application should be directed to the Examiner listed below.

Response to Arguments

Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8, 10-18, and 20-25 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Application Publication 2002/0163662 to Kaufman et al.

Regarding claim 1, Kaufman discloses an electronic service transaction apparatus, comprising:

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a computer peripheral device (referred to throughout the reference as "printer") having a communication link with an electronic service site ("destination" such as a "web site" or "consumable media order-fulfillment house"); (paragraph 0016 and 0033) and

a messaging system configured to communicate between the computer peripheral device and the electronic service site and operative to enable sending and receiving of at least one of messages and information between the computer peripheral device and the electronic service site, (paragraph 0033) wherein the communication link connects the computer peripheral device with the Internet (paragraph 0016 and 0031), and the computer peripheral device is configured to initiate an electronic service transaction ("automatically placing an order") with the electronic service site through self-access of the messaging system. (paragraphs 0014, 0033 and 0034)

Regarding claim 2, Kaufman discloses the apparatus of claim 1 wherein the computer peripheral device comprises an embedded web server ("communications apparatus" capable of communicating "over a TCP/IP connection" using "HTTP"), and wherein the embedded web server is operative to forward a request for an electronic service to the electronic service site from the

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computer peripheral device via the messaging system. (paragraphs 0014, 0030 and 0033)

Regarding claim 3, Kaufman discloses the apparatus of claim 1 wherein the computer peripheral device comprises a messaging system that enables initiation of an electronic service transaction from an electronic service site. (paragraphs 0014, 0033 and 0034)

Regarding claim 4, Kaufman discloses the apparatus of claim 1 wherein the communication link comprises an electronic communication link provided by a mail client of the computer peripheral device that enables a user to submit an e-mail order using a mail program from the computer peripheral device to an external provider of electronic services. (paragraphs 0014, 0033 and 0034, specifically "e-mail")

Regarding claim 5, Kaufman discloses the apparatus of claim 1 wherein the messaging system comprises an e-mail system including a mail program operative to enable sending and receiving of at least one of messages and information between the computer peripheral device and an external electronic service site. (paragraphs 0014, 0033 and 0034, specifically "e-mail")

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Regarding claim 6, Kaufman discloses the apparatus of claim 1 wherein the messaging system comprises a dedicated Internet connection. (paragraph 0030)

Regarding claim 8, Kaufman discloses the apparatus of claim 1 wherein the computer peripheral device automatically generates a consumable order message in response to the computer peripheral device detecting a need to replenish a consumable and further forwards a notification to a consumable order web site on an external web server indicating a need to replenish the consumable. (paragraph 0033)

Regarding claim 10, Kaufman discloses a computer peripheral device ("printer"), comprising:

- an output engine; ("print mechanism")

- a transaction execution subsystem communicating with the output engine; ("communications apparatus" capable of communicating "over a TCP/IP connection" using "HTTP")

- a communication interface communicating with the transaction execution subsystem ("display" and "operating panel"; paragraph 0029); and processing circuitry communicating with the transaction execution subsystem and operative to initiate an electronic services transaction through self-access from the transaction execution subsystem using the communication

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interface via an external network with an electronic services provider. (paragraphs 0014, 0033 and 0034)

Regarding claim 11, Kaufman discloses the computer peripheral device of claim 10 wherein the output engine comprises a print engine ("print mechanism") communicating with the transaction execution subsystem. (paragraph 0030)

Regarding claim 12, Kaufman discloses the computer peripheral device of claim 10 wherein the communication interface comprises a user interface of a computer peripheral device. ("display" and "operating panel"; paragraph 0029)

Regarding claim 13, Kaufman discloses the computer peripheral device of claim 10 wherein the transaction execution subsystem comprises an embedded web server. ("communications apparatus" capable of communicating "over a TCP/IP connection" using "HTTP")

Regarding claim 14, Kaufman discloses The computer peripheral device of claim 13 wherein the processing circuitry is provided by a central processing unit (CPU), and the CPU is further operative to carry out an e-services transaction using the transaction execution subsystem of the computer peripheral device. (paragraphs 0014, 0033 and 0034)

Regarding claim 15, Kaufman discloses a method of initiating an electronic services transaction, comprising:

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providing a computer peripheral device having a communication link with an electronic service site and an interface system for initiating an electronic service transaction between the computer peripheral device and the electronic service site; (paragraphs 0014, 0033 and 0034)

detecting a need to initiate an electronic computer peripheral servicing transaction from the computer peripheral device with an external electronic service site; and initiating the electronic computer peripheral servicing transaction in response to the detected need using the computer peripheral device. (paragraph 0033)

Regarding claim 16, Kaufman discloses the method of claim 15 wherein the computer peripheral device comprises an embedded web server ("communications apparatus" capable of communicating "over a TCP/IP connection" using "HTTP"), the electronic service site comprises a site web server and the communication link comprises an Internet messaging system extending between the computer peripheral device and the site server. (paragraphs 0014, 0030 and 0033)

Regarding claim 17, Kaufman discloses the method of claim 15 wherein detecting a need for an electronic services transaction comprises receiving a user input at a user interface

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of a computer peripheral device that initiates an e-services transaction. (paragraph 0015)

Regarding claim 18, Kaufman discloses the method of claim 15 wherein the computer peripheral device comprises a printer. ("printer")

Regarding claim 20, Kaufman discloses the method of claim 18 wherein the printer completes an electronic services transaction with the electronic service site. (paragraph 0037)

Regarding claim 21, Kaufman discloses the apparatus of claim 1, wherein self-access of the messaging system is via at least one of a self-initiated wake-up, a timed event, a polled event and a trigger state. ("alert message"; paragraph 0033)

Regarding claim 22, Kaufman discloses the apparatus of claim 1, wherein the electronic service transaction includes sending information related to one or more maintenance needs of the computer peripheral device to the electronic service site. (paragraph 0033)

Regarding claim 23, Kaufman discloses the device of claim 10, wherein self-access of the messaging system is via at least one of a self-initiated wake-up, a timed event, a polled event and a trigger state. ("alert message"; paragraph 0033)

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Regarding claim 24, Kaufman discloses the method of claim 15, wherein initiating the electronic computer peripheral servicing transaction is through self-access by the computer peripheral device. (paragraph 0033)

Regarding claim 25, Kaufman discloses the method of claim 15, wherein self-access of the messaging system is via at least one of a self-initiated wake-up, a timed event, a polled event and a trigger state. ("alert message"; paragraph 0033)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman et al. in view of Japanese Patent Application Publication 11-134126 to Nobuyuki.

Regarding claim 7, Kaufman discloses the apparatus of claim 1.

Kaufman discloses wherein the computer peripheral device connects with an external server via the Internet. (paragraphs 0014, 0030 and 0033)

Kaufman does not expressly disclose wherein the computer peripheral device accesses a document on the external server to

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render a web page, and the electronic service transaction comprises sending a URL for the document to the electronic service, and receiving a print stream from the external server for the document, however, Kaufman does disclose that the computer peripheral device allows for the transfer of data from an external server to the printer and that the printer sends HTTP data from the printer to the external web server (paragraphs 0014 and 0031).

Nobuyuki does disclose the above limitations (see Derwent abstract, specifically "The mode executor acquires the world wide web (WWW) server access data via a network. In web print mode the acquired data is converted to image data and printed...The data printer improves the operatively of printing acquired data from WWW server") (see also paragraph 0011 of English translation)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since Nobuyuki discloses that the printer can directly receive documents from the web server and print the document without any intermediary device or processor (see Derwent abstract and paragraph 0011). In view of these specific advantages and that the references are directed to computer peripheral devices having web servers allowing the transfer of

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data to and from external web sites, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Regarding claim 9, Kaufman discloses the apparatus of claim 1 wherein the computer peripheral device comprises a printer connected with the Internet via the communication link paragraphs 0014, 0030 and 0033).

Kaufman does not disclose wherein a user accesses a document on the Internet via the printer and prints the document using the printer.

Nobuyuki does disclose the above limitations (see Derwent abstract, specifically "The mode executor acquires the world wide web (WWW) server access data via a network. In web print mode the acquired data is converted to image data and printed...The data printer improves the operatively of printing acquired data from WWW server") (see also paragraph 0011 of English translation)

Claim 9 is rejected since the motivations regarding the obviousness of claim 7 also apply to claim 9.

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Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman et al in view of US Patent Application Publication 2003/0158790 to Kargman.

Regarding claim 19, Kaufman discloses the method of claim 18.

Kaufman does not expressly disclose wherein detecting a need for an electronic services transaction comprises detecting a need to order toner, however, Kaufman does suggest that other printer supplies may be detected for a need for an electronic services transaction (paragraph 0033, specifically "the like).

Kargman discloses wherein a means detects a need to order toner and completes an electronic transaction at an electronic service site (paragraph 0042).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since Kargman discloses that automatic ordering of toner removes the user from having to manually complete transactions for consumable goods (paragraph 0006), to which Kaufman also concurs (paragraph 0007 and 0008). In view of these specific advantages and that the references are directed to automatically ordering printer supplies in order to avoid a user to manually order the supplies from an electronic service site, one of ordinary skill would have been motivated to combine

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these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Conclusion

The prior art listed in the PTO-892 form included with this Office Action disclose methods, systems, and apparatus similar to those claimed and recited in the specification. The Examiner has cited these references to evidence the level of common knowledge of one of ordinary skill in the art at the time of the invention, to provide support for universal facts and the technical reasoning for the rejections made in this Office Action including the Examiner's broadest reasonable interpretation of the claims as required by MPEP 2111 and to evidence the plain meaning of any terms not defined in the specification.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this

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action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

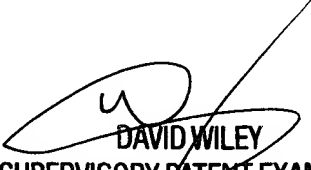
Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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